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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,272	11/09/2000	Timothy Norris	62814-A/JPW/GJG	6700

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EXAMINER

MCKENZIE, THOMAS C

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 12/13/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/711,272

Applicant(s)

NORRIS ET AL.

Examiner

Thomas McKenzie Ph.D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7,14-32,50 and 52-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,14-32,50 and 52-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to an application filed on 11/9/00. There are thirty claims pending and under consideration. Claims 1-4 are compound claims. Claims 5-7 are composition claims. Claims 14-23 and 50 are use claims. Claims 24-32 and 52-54 are method of making claims. This is the first action on the merits. The application concerns a specific crystal form of N-(3-ethynylphenyl)-6,7-bis(2-methoxyethoxy)-4-quinazolinamine, monohydrochloride, which has Chemical Abstracts registry number 183319-69-9.

#### ***Information Disclosure Statement***

2. The file wrapper refers to an IDS filed on 6/29/01. However, the Examiner cannot find the PTO-1449 or any references in the file.

#### ***Claim Objections***

3. Objection is made to claims 2-4 under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The four claims concern the B polymorph of N-(3-ethynylphenyl)-6,7-bis(2-methoxyethoxy)-4-quinazolinamine, monohydrochloride. There Applicants state

that only two polymorphs are known, A and B. There are only two purity limitations in the four objected claims, “substantially homogeneous” in claim 1 and “substantially free of the A polymorph” in claim 3. The Examiner can see no difference in these limitations. Thus, all four claims are to the same substance with the same purity limitation.

4. Objection is made to claims 6 and 7 under 37 CFR 1.75 as being a substantial duplicate of claim 5, for reasons cited above.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The three rejected claims are compositions containing polymorph B and all lack a carrier.

6. Claims 14 and 17-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “a hyperproliferative disorder” is indefinite. From the dependant claims, it is clear that this disorder

includes solid tumors. Are leukemias also covered? Is psoriasis “a hyperproliferative disorder”? Would hirsutism be covered?

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14 and 16-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants are not enabled for treatment of “a hyperproliferative disorder” generally. Evidence involving a single compound and two types of cancer was not found sufficient to establish the enablement of claims directed to a method of treating seven types of cancer with members of a class of several compounds *In re Buting* 163 USPQ 689.

To make clearer the lack of enablement for treatment of all cancer, extrinsic evidence is supplied by Draetta (Ann. Reports Med. Chem.), final sentence on page 246 “Although many still think about the need for a magic bullet as a cure for all cancers, our knowledge of the molecular mechanism underlying this disease make the prospect of developing such a universal cure very unlikely.” Since no universal cure for cancer has been developed, it follows that there is no correlation

between the assays relied upon by applicants and the ability to treat all cancers. Thus, those assays are not sufficient to enable such claims.

The remarkable advances in chemotherapy have seen the development of specific compounds to treat specific types of cancer. The great diversity of diseases falling within the "tumor" category means that it is contrary to medical understanding that any agent (let alone a genus of thousands of compounds) could be generally effective against such diseases. The intractability of these disorders is clear evidence that the skill level in this art is low relative to the difficulty of the task.

8. Claim 50 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants are not enabled for preventing cancer. The only established prophylactics are vaccines not the N-(3-ethynylphenyl)-6,7-bis(2-methoxyethoxy)-4-quinazolinamine, monohydrochloride such as present here. Despite intensive efforts, pharmaceutical science has been unable to find a way of getting a compound to be effective for the prevention of proliferative diseases generally. Under such circumstances, it is proper for the PTO to require evidence that such an unprecedented feat has actually been

accomplished, *In re Ferens*, 163 USPQ 609. No such evidence has been presented in this case. The failure of skilled scientists to achieve a goal is substantial evidence that achieving such a goal is beyond the skill of practitioners in that art, *Genentech vs Novo Nordisk*, 42 USPQ2nd 1001, 1006.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-7, 14-23, 50, and 52-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Schnur ('498). The reference teaches the synthesis and crystallization of N-(3-ethynylphenyl)-6,7-bis(2-methoxyethoxy)-4-quinazolinamine,

monohydrochloride in Example 20, lines 30-49, column 22. Applicants have amply characterized their material, polymorph B but there is no side-by-side comparison to the material taught by the reference. Is the material made by Schnur ('498) polymorph A? Applicants state that polymorph B is the more stable form. One might expect that earlier workers also found the more stable form. Could the material prepared by Schnur ('498) contain some or substantial amounts of polymorph B?

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schnur ('498). The reference teaches crystallization of N-(3-ethynylphenyl)-6,7-bis(2-methoxyethoxy)-4-quinazolinamine, monohydrochloride from chloroform and ether. The Applicants claim crystallization from water and alcohol. The difference between the claimed and taught processes is the solvent employed. Changes in solvent are a matter of routine experimentation to the process chemist trying safer and less flammable solvents for the pilot plant. No more than routine skill is



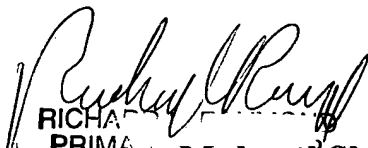
required for the process chemist to optimize the solvent choice. To quote the Board of Patent Appeals and Interferences *Ex parte Goldschmidt*, 123 USPQ 41 "It is our opinion that it does not amount to invention for the skilled chemist ... to determine ... which specific organic solvent is most suitable".

**Conclusion**

11. Please direct any inquiry concerning this communication or earlier communications from the Examiner to Thomas C McKenzie, Ph. D. whose telephone number is (703) 308-9806. The FAX number for the Examiner is (703) 746-3152. The Examiner is available from 8:30 to 5:30, Monday through Friday. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mukund Shah can be reached on (703) 308-4716. Please direct general inquiries or any inquiry relating to the status of this application to the receptionist whose telephone number is (703) 308-1235.

TCMcK  
December 6, 2001



  
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